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No. 06-338

In the Supreme Court of the United States

CATHERINE LACAVERA

Petitioner,

v.

JOHN W. DUDAS,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITIONER'S REPLY BRIEF

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REPLY BRIEF FOR PETITIONERS

In an attempt to justify the *ultra vires* and unconstitutional USPTO rules pertaining to the registration and limited recognition of aliens, the respondent erroneously asserts that the USPTO granted petitioner limited recognition that was "consistent" with her visa. The limits of petitioner's limited recognition were never consistent with any of her visas and were far more restrictive. The USPTO changed the limits of petitioner's recognition in response to petitioner's challenges to those limits in an *ex post facto* attempt to make the limits appear less burdensome and more "consistent" with her visas, but the USPTO never achieved consistency.

The respondent cannot distinguish the USPTO rules at issue here from the state bar rules at issue in *Leclerc* and *Wallace*, and these cases should be reviewed by the Court together.

This case is not moot. Although the USPTO finally registered petitioner, her registration is still improperly conditioned on her maintaining her immigration status and residency in the United States. Without this Court's review, the USPTO could change its rules and policies, as it has done repeatedly during the course of this lawsuit, to restrict further the employment opportunities of petitioner and other aliens. For these reasons, the Court should grant the petition for a writ of certiorari.

REPLY TO RESPONDENT STATEMENT

1. Congress did not delegate to the USPTO authority over matters of citizenship and immigration. The USPTO is authorized to evaluate an attorney's competency to practice before it, not the terms of the attorney's visa.

The respondent mistakenly cites 37 C.F.R. §§ 11.6-11.9 as the rules applicable to this appeal. *See* 69 Fed. Reg. 35428 (June 24, 2004). The prior rules, 37 C.F.R. §§ 10.6-10.9 (2003), were applied to petitioner. (A3 n. 1.) The USPTO changed the rules in an *ex post facto* attempt to justify and

entrench in the rules the USPTO's discriminatory treatment of nonimmigrant aliens. Limited recognition was revised to apply to nonimmigrant aliens, whereas the prior rule did not refer to nonimmigrant aliens. (*Compare* 37 C.F.R. § 11.9 *and* 37 C.F.R. § 10.9 (2003)). The limits the USPTO imposed on petitioner's recognition are not part of the current or former USPTO rules and were not defined pursuant to any notice-and-comment rulemaking procedures. The USPTO defined these limits on a case-by-case basis each time petitioner changed or renewed her visa or renewed her limited recognition. (*See e.g.*, A25-27, SRA 5.)

2. a. Respondent mistakenly claims that petitioner's limited recognition was "consistent" with her visa. In fact, the USPTO never granted Lacavera limited recognition that was "consistent" with her visa. The USPTO imposed limits on Lacavera's recognition that were far more restrictive than her visas. For example, the USPTO limited Lacavera to preparing and prosecuting patent applications wherein "the patent applicant is the client of the White & Case law firm" and "the attorney or agent of record in the applications is a registered practitioner who is a member of the White & Case law firm." (*See e.g.*, A25-27.) Her visas never restricted her to representing only patent applicants, as opposed to assignees or other persons having business before the patent office. (*See e.g.*, A42, A46-63.) Her visas also never required her to work under the supervision of a fully registered patent practitioner who also was of record. *Id.* The USPTO also required Lacavera to renew her limited recognition annually, despite the fact that her H1-B visas were valid for three years. (*See* A25-27, A203-207.) Unlike registered practitioners, Lacavera did not receive a registration number and did not appear on the roster of registered attorneys maintained by the USPTO. As a result, she was required to prove her limited recognition status by filing a copy of her limited recognition papers in each patent application she prosecuted. (A27.)

None of these limitations were required by her visas. (*See e.g.*, A42, A46-63.) When petitioner began working for Google Inc. in 2005 (not 2003 as indicated by respondent (Brief for the Respondent in Opposition ("Opposition"), at 3)), the USPTO limited Lacavera to "prepar[ing] and prosecut[ing] patent applications wherein the *assignee of record of the entire interest* is Google, Inc. [sic]." (SRA 5 (emphasis added.)) In contrast, Lacavera's visa allowed her to act on Google's behalf to prepare and prosecute patent applications regardless of the assignee of record. (SRA 1-4.)

The USPTO lifted some of these limits in response to petitioner's challenges (*see* Petitioner's Petition For a Writ of Certiorari ("Petition"), at 12 n 5.), but it was never fully consistent with her visas.

b. In contrast to limited recognition, which was inconsistent with petitioner's visas, full registration is consistent with all of petitioner's visas. All of petitioner's visas authorized her to practice as a patent attorney before the USPTO. (*See e.g.*, SRA 1-4, A42, A46-63.) Nothing in any of her visas has ever prevented her from being registered as a patent attorney. *Id.* Registration as a patent attorney does not exempt her from complying with her visa restrictions.

c. Registration as a patent attorney also does not authorize petitioner to exceed her visa restrictions. Registration as a patent attorney is granted subject to compliance with all laws, including immigration laws. The USPTO has no authority to permit petitioner to exceed her visa. Petitioner is limited to the terms of her visas irrespective of any action by the USPTO.

3. Respondent omits that Petitioner's application for permanent residence status was granted on September 25, 2006, twenty days after she filed her Petition. Letter from Lacavera to Harry I. Moatz, Director of Enrollment and Discipline, USPTO (Oct. 4, 2006). Respondent sought three

extensions of time before finally filing its Opposition on January 16, 2006. In the meantime, on December 11, 2006, the USPTO granted petitioner registration as a patent attorney. Letter from Shirley A. Martin, Enrollment Program Specialist, Office of Enrollment and Discipline, USPTO, to Lacavera (Dec. 15, 2006). Lacavera's registration as a patent attorney is still conditioned upon her visa status as a permanent resident and her continued residence in the United States. *See* 37 C.F.R. 11.6(a) ("alien may remain registered only: ... [i]f the alien continues to lawfully reside in the United States and registration does not become inconsistent with the terms upon which alien continues to lawfully reside in the United States"); *see also* Letter from Shirley A. Martin, Enrollment Program Specialist, Office of Enrollment and Discipline, USPTO, to Lacavera (Oct. 24, 2006).

REPLY TO RESPONDENT ARGUMENT

I. The Statutory Authority Of The USPTO To Limit The Recognition Of Aliens Should Be Reviewed

1. The USPTO lacks the statutory authority to limit the recognition of aliens seeking registration to practice before it. Congress authorized the USPTO to evaluate attorneys' competency, not their citizenship, immigration status or residency. Not only is the USPTO not authorized to evaluate immigration status, it is not capable of doing so properly, as the facts of this case demonstrate. After over four and half years of pendency of this dispute, despite making multiple changes to its rules, policies and the limits of petitioner's recognition, the USPTO never achieved "consistency" between petitioner's visa and her limited recognition. Petitioner's limited recognition was far more restrictive than her visas.

The respondent misapplies the holding in *Chevron U.S.A., Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837 (1984) to argue that the USPTO's rules must be upheld as long as they are reasonable. (Opposition, at 8.) On the

contrary, since Congress expressly limited the requirements the USPTO may impose on applicants for registration, and those requirements do not include U.S. citizenship, residency or immigration status, the USPTO has no discretion to impose such requirements. *Id.* at 842-43 ("If the intent of Congress is clear, that is the end of the matter; for the court, as well as the agency, must give effect to the unambiguously expressed intent of Congress."). Moreover, the USPTO rules are not reasonable: they are arbitrary and arbitrarily applied. It is arbitrary for the USPTO to expressly limit aliens to the terms of their visas, as the USPTO interprets those limits, when it does not expressly limit applicants for registration to complying with any other laws. The USPTO is also arbitrary in its imposition of limits to recognition of aliens that it defines on a case-by-case basis and that are more restrictive than their visas.

The USPTO is not merely recognizing limits imposed by the DHS but is attempting to interpret and enforce those limits and failing to do so properly. The USPTO refuses to register nonimmigrant aliens for the purported purpose of preventing them from exceeding their visas. It attempts to interpret aliens' visas and imposes limits on their recognition based on its faulty interpretation, as seen in this case. The USPTO is interfering with the authority of the DHS by imposing limits on nonimmigrant aliens that exceed the limits imposed by the DHS.

Registration as a patent attorney does not give petitioner any "cover to hold herself out as something she truly is not." (Opposition, at 8.) Registration establishes qualifications to practice before the USPTO, not immigration status. Petitioner was fully qualified for registration, regardless of her immigration status, when she met all of the legal, technical and character requirements for registration and passed the examination. (*See* A111, A120, A181.) She was entitled to receive full registration in order to establish her

qualifications to practice, not her immigration status. A license to practice before the USPTO cannot be mistaken for a license to work in the United States because the USPTO has no authority to grant a work visa. Petitioner is fully admitted to practice before several state bars and federal courts, including this Court, none of which afford her any improper "cover" or establish anything other than her qualifications to practice. The USPTO itself registers Canadians living in Canada who have no authorization to work in the United States (*see* 37 C.F.R. § 11.6(c); *see also* 37 C.F.R. § 10.6(c) (2003)), so there is no reason for the USPTO to deny nonimmigrant aliens registration based on their limited authorization to work in the United States.

II. The Standard Of Review Of Federal Agency Rules Disadvantaging Aliens Should Be Reviewed

2 a. This Court is not limited to mere "rational review" of federal agency rules discriminating against aliens where, as here, the agency has no special interest in immigration and naturalization. The respondent is mistaken in arguing that *Mathews v. Diaz*, 426 U.S. 67 (1976) limits this Court to only "rational review." (Opposition, at 9.) *Mathews* concerned the constitutionality of an act of Congress, the Social Security Act, and the Court recognized that the broad power of Congress over naturalization and immigration permitted only a narrow standard of review over its decisions in that area. *Mathews,* 426 U.S. at 79-82. The present challenge concerns the constitutionality of a discriminatory rule enacted by a federal agency that possesses no authority over naturalization and immigration.

The USPTO's interest in ensuring competency of registered practitioners and minimizing unauthorized practice before it is no different than the interest of every state bar, including the state bar of Louisiana that is involved in the *Leclerc* and *Wallace* cases. Since the USPTO has no special national interest that would justify a more deferential standard

of review of its discriminatory rule, at least "heightened scrutiny," if not "strict scrutiny," should have been applied to the USPTO rule denying registration to nonimmigrant aliens. *Cf. Hampton v. Mow Sun Wong*, 426 U.S. 88, 101-105 (1976); *cf. Ramos v. U.S. Civil Service Comm'n*, 376 F. Supp. 361, 366 (D.P.R. 1974), *aff'd in relevant part*, 426 U.S. 916 (1976).

The respondent seeks to distinguish *Hampton*, *Leclerc* and *Wallace* on the ground that those cases involve total denials of employment opportunities, whereas the USPTO grants "limited recognition," the limits of which it defines on a case-by-case basis. Denying employment opportunities might be more burdensome than granting limited opportunities, depending on the limits the USPTO chooses to impose, but anything less than full registration to practice before the USPTO, without limits or conditions, is unequal treatment that requires the review of this Court. While the USPTO has gradually lifted the limits it imposed on petitioner in response to Lacavera's challenges to those limits (*see* Petition, at 12 n. 5.), without direction to the contrary by this Court, the USPTO would have judicial sanction to revert to its former position or impose further, more burdensome limits on aliens.

III. The USPTO's Unequal Treatment Of Aliens Should Be Reviewed

b. Petitioner never argued that she was being treated differently than other nonimmigrant aliens with work visa restrictions. The USPTO discriminates against all nonimmigrant aliens equally by wrongly denying registration to all of them. The USPTO's refusal to register nonimmigrant aliens is not even rationally related its claimed interest in "minimizing the unauthorized practice of law before the [US]PTO and its attendant public harm." (Opposition, at 11.) The USPTO has no reason to presume that aliens are any more likely to engage in unauthorized practice before it than any other applicant for registration.

There is no reason for the USPTO to presume that registering nonimmigrant aliens as patent attorneys would induce them to violate their visas or engage in any other unauthorized practice. No other state bar or federal court was concerned that granting petitioner full admission to practice before it would induce her to violate her visas.

There is no rational basis for the USPTO to single out nonimmigrant aliens and expressly limit their recognition to their visas terms, as the USPTO interprets those terms, when the USPTO does not expressly limit recognition to the terms of any other law. There is no reason for the USPTO to presume that aliens are more likely to violate their visas than any other applicant for registration is likely to violate any other law. The USPTO's discriminatory rule rests on a baseless presumption that aliens are more likely to be guilty of unauthorized practice before it than other applicants for registration.

IV. This Case Is Not Moot

3. This case is not moot because this Court still has the power to grant petitioner a meaningful remedy by striking down the USPTO rules to the extent that they impose immigration status and residency conditions on petitioner's registration as a patent attorney. Mootness turns on whether this court can award petitioner any effectual relief. *See e.g.*, *Church of Scientology of California v. United States*, 506 U.S. 9, 12 (1992) (citations omitted). Although the USPTO did finally register petitioner as a patent attorney over four and half years after she met all of the requirements for registration (Letter of Dec. 15, 2006, *supra*; A181), her registration is still improperly conditioned on her maintaining her immigration status and residency in the United States. *See* 37 C.F.R. § 11.6.

This case is also not moot because the USPTO could change its rules and policies, as it has done repeatedly during the course of this lawsuit, to impose other, more burdensome,

limits on petitioner and other aliens seeking registration to practice before it. Thus, the USPTO has not met its heavy burden of establishing this case is moot. *See Friends of the Earth, Inc. v. Laidlaw Envtl. Servs. (TOC), Inc.*, 528 U.S. 167, 189 (2000). Without this Court's review, the USPTO or any other federal agency with no authority over immigration matters would be judicially sanctioned to restrict the employment opportunities of aliens.

Even if this case were otherwise rendered moot, it falls into the exception to mootness because the issues presented are "capable of repetition yet evading review." *See e.g.*, *Honig v. Doe*, 484 U.S. 305, 318 (1988) (citations omitted); *Roe v. Wade*, 410 U.S. 113, 125 (1973). The USPTO's refusal to register petitioner is "capable of repetition." If petitioner resides outside of the United States or her immigration status changes such that she is no longer an immigrant alien, her registration as a patent attorney will be revoked. *See* 37 C.F.R. 11.6(a). The USPTO appears to recognize that this issue is "capable of repetition" because it has already warned petitioner as follows: "If you cease to maintain permanent residence status in the United States, even temporarily, you must promptly notify the Director. *See* 37 C.F.R. 10.23(c)(14)." Letter of Oct. 24, 2006, *supra*. Section (c)(14) of USPTO rule 10.23 provides that it is misconduct to "[k]nowingly fail[] to advise the Director [of the USPTO] in writing of any change which would preclude continued registration under § 10.6 [now § 11.6]."

This Court has stated that the purpose of the "capable of repetition" test is to determine "whether the controversy was *capable* of repetition and not . . . whether the claimant had demonstrated that a recurrence of the dispute was more probable than not." *Honig*, 484 U.S. at 320 n.6 (emphasis in original) (citing numerous cases in which this Court "found controversies capable of repetition based on expectations that, while reasonable, were hardly demonstrably probable.") It is

certainly possible that petitioner's immigration status or residency could change. She is employed by a global company with offices around the world. (SRA 2.) Her previous employer was a global law firm with offices around the world. (A61.) She has already relocated for employment from Canada to New York and then to California. (A 61-62; SRA 2.)

The USPTO's refusal to register nonimmigrant aliens also "evades review" because nonimmigrant status is temporary and therefore aliens who intend to remain in the United States must seek immigrant status. Petitioner's TN nonimmigrant visas were valid for one year (*see e.g.*, A81) and her H1-Bs visas were valid for three years (*see e.g.*, SRA 1), subject to renewal. Although the time it takes to attain immigrant status is variable, it can be too brief to obtain review. Petitioner's current employer sponsored her application for immigrant status that was granted twenty days after petitioner filed the Petition and less than a year after the application was filed. Letter of Oct. 4, 2006, *supra*. Petitioner's prior employer sponsored her application for immigrant status (Corrected Brief for Plaintiff-Appellant at 3 n. 1) but that application was still pending three and a half years later when she changed employers (SRA 1).

Even if this case was rendered moot by the USPTO's registration of petitioner as a patent attorney, the petition for a writ of certiorari should be granted and the judgments below vacated to clear the path for future litigants to challenge the USPTO rules pertaining to registration and limited recognition of aliens.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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Dated: January 30, 2007